



UNITED STATES DEPARTMENT OF COMMERCE
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TA

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/579,599	05/26/00	ZAVISLAN	J ML-0362C2

QM12/1011
KENNETH J LUKACHER
SOUTH WINTON COURT
3136 WINTON ROAD SOUTH SUITE 304
ROCHESTER NY 14623

EXAMINER

FARAH, A

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/579,599

Applicant(s)
Zavislan et al.

Examiner
A. Farah

Art Unit
3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-43 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4,6,7
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 3739

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 27-31, 33 and 34 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Charles J. Koester "Scanning mirror microscope with optical characteristics: applications in ophthalmology." Appl. Opt. Vol. 19, No. 11, June 1980.

Koester teaches method and apparatus for examining a number of biological tissues using incident light microscopy. Fig. 2 of Koester shows a microscopic imaging apparatus for pathological applications, the apparatus comprising:

a) objective lens, b) window which has a surface capable of being in pressure contact relationship with the surface of a tissue sample, c) illumination beam which is focused by the objective lens through the window to the tissue sample, and d) a return signal, from the tissue sample, which carries pathological information of the sample. In reference to claim 31, Koester's window is transparent to the illumination light. In reference to claim 33, he teaches that the numerical aperture of the objective lens is selected based on the area being viewed. See equation 2.

Art Unit: 3739

3. Claims 27-31 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Harris U.S. Pat. No. 5,120,953.

Harris discloses a scanning confocal microscope comprising: a) a light source for supplying illumination light, b) focussing lens which focuses the light onto an object/tissue to be examined, and c) window that is transparent to both the illumination light from the source and the back-scattered light from the tissue being examined. Fig. 8 of Harris shows that the window is in pressure contact with the tissue being examined (the sample tissue). He further teaches that the return signal from the sample tissue is viewed by imaging means 37.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 32 and 35-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koester in view of Zalvislan U.S. Pat. No. 5,788,639.

Koester, described above, does not specifically describe if the instrument is handheld and his imaging method is directed to a corneal surface, not to tumorous tissue.

Art Unit: 3739

Zalvislan discloses a handheld confocal imaging method and system for observation and diagnosis of dermal and subdermal tissue conditions. He teaches that his imaging system provides diagnosis of basal cell carcinomas and melanomas, and also enables visualization of tumor borders. Therefor, it would have been obvious to one having the ordinary skill in the art at the time of the applicant's invention to modify Koester with Zalvislan to have a handheld microscopic device in order to provide diagnosis and visualization of tissues on a living body. Further, it would have been to utilize the microscope in order to analyze tumor tissues.

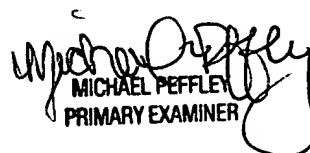
Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following reference:

Zavislan et al.

U.S. Pat. No. 6,263,233

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703)305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Linda Dvorak, can be reached on (703) 308-0994. The fax number for the Examiner is (703)746-3368.


MICHAEL PEFFLEY
PRIMARY EXAMINER